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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,855	04/06/2001	Krister Draxo	7112	8864

7590 09/25/2003
JOHNS MANVILLE INTERNATIONAL, INC.
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EXAMINER

BOYD, JENNIFER A

ART UNIT PAPER NUMBER

1771

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A-5

Office Action Summary	Application No. 09/827,855	Applicant(s) DRAXO ET AL.	
	Examiner Jennifer A Boyd	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 20 is/are pending in the application.
- 4a) Of the above claim(s) 1, 4 and 12 - 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-11 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1 page</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. The Applicant's Amendments and Accompanying Remarks, filed June 6, 2003, have been entered and have been carefully considered. Claims 1 – 3, 5 – 10, 16 and 17 are amended, new claims 18 – 20 have been added and claims 1 – 20 are pending. In view of the Applicant's amendments, the Examiner withdraws the 35 U.S.C. 112, 2nd paragraph rejection of claims 16 and 17 as set forth in paragraphs 6 – 7 of the Office Action dated March 12, 2003. In view of the Applicant's amendments, the Examiner withdraws the rejection of claims 16 – 17 under 35 U.S.C. 102(b) as being anticipated by Murch (U.S. 3,934,066) as set forth in paragraph 9 of the Office Action dated March 12, 2003. However, after an updated search, additional prior art was found which renders the invention as currently claimed unpatentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

1. Claims 1, 4 and 12 – 15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: In the instant case the product as claimed can be made by another and materially different process such as dip coating.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

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on the merits. Accordingly, claims 1, 4 and 12 – 15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. Claims 1, 4, 7, 9 and 12 – 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 4 and 12 – 15 are rejected as being dependent on rejected claim 1.

4. Claim 1 recites the limitation “a process for forming a strippable glass fiber wall covering according to claim 17” in lines 1 and 2 of claim 1. Claim 17 is drawn to a strippable glass fiber wall covering but does not mention a process for forming the wall covering. It should be noted that if the Applicant amends claim 17 to be a product-by-process claim, then claims 1 and depending claims 4 and 12 – 15 will be considered.

5. Claims 7 and 9 recite the limitation "said aqueous dispersion" in lines 2 of claim 7 and line 2 of claim 9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 3, 5 – 7, 16 – 17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Andersen et al. (US 6,200,404).

Andersen et al. is directed to compositions and method for manufacturing starch-bound matrix reinforced with fibers (Abstract). It should be noted that the sheets may be used in any application where convention paper or paperboard products have been used (column 47, lines 13 – 15).

As to claims 16 and 17, Andersen teaches a moldable composition comprising an ungelatinized starch binder (column 6, lines 15 – 20), water-dispersible latexes (column 18, lines 25 – 27) and fibers such as glass fibers (column 23, lines 65 – 67 and column 24, lines 20 – 30). It should be noted that the glass fibers of the composition are considered to be in a non-woven fabric form. According to Complete Textile Glossary, a non-woven, in one embodiment, an assembly of textile fibers held together by bonding with a cementing medium such as starch or latex. The moldable composition is prepared by mixing the elements, extruding the mixture into a sheet, passing the sheet through a set of rollers that gelatinize the starch and further drying and compacting the composition to produce the final sheet (column 27, lines 20 – 40). The Applicant's "first dried coating" is contained within the entirety of the non-woven fabric, and therefore, covers both sides of the fabric. Andersen further teaches that the starch-bound sheets, or moldable composition, may be optionally coated with an adhesive, equated to Applicant's "second dried coating" (column 43, lines 60 – 65). The coating is in the form of a film which is applied on the surface of the sheet (column 43, lines 66 – 67 and column 44, lines 1 – 5). The film coating can be obtained by spraying or dipping into a vat (column 44, lines 10 – 20). Suitable coating materials include cellulosic ethers such as METHOCEL, known in the art to be

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a rheology modifier, and waxes such as paraffins (column 44, lines 20 – 37 and column 45, lines 1 – 7). Andersen notes that the coatings may be single component or mixed with one or more of the organic coatings (column 44, lines 34 – 36).

As to claim 3, Andersen teaches that the fibers can be glass fibers (column 23, lines 65 – 67 and column 24, lines 20 – 30) and are considered to be in a non-woven fabric form as discussed above.

As to claim 5, Andersen teaches that the starch can be a potato starch (column 15, lines 40 – 46).

As to claim 6, Andersen teaches that water-dispersible synthetic organic polymers such as polyacrylic acids can be used in the composition.

As to claim 7, Andersen teaches that a cross-linking admixture can be present in the moldable composition (column 26, lines 24 – 28).

As to claim 20, Andersen teaches the rheology modifier can be METHOCEL, which is a cellulosic ester (column 44, lines 25 – 30).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 5, 7 – 8 and 17 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edlund (US 6,291,011) in view of Fagan (US 4,783,354).

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Edlund is directed to a glass fiber wallcovering (Abstract).

As to claim 17, Edlund teaches a first coating is applied to a glass fabric, particularly a woven product from fiberglass yarn. (column 2, lines 57 – 60). Edlund teaches that the glass woven fabric is fed into an impregnation bath comprising potato starch and vinyl acetate ethylene copolymer (column 3, lines 15 – 35). It should be noted that the vinyl acetate ethylene copolymer that is suspended in the water-based mixture (column 3, lines 35 – 40) is considered to be a latex. A latex is defined as an emulsion of rubber or plastic globules in water. Edlund teaches that typically a water based glue system is used to apply the treated glass fabric to the wall (column 4, lines 25 – 30).

As to claim 2, Edlund teaches that the glass fabric is a woven fabric (column 2, lines 57 – 60).

As to claim 5, Edlund teaches that the impregnation bath contains potato starch (column 3, lines 15 – 35).

As to claims 7 and 8, Edlund teaches that the impregnation bath additionally contains ammonium zirconium carbonate, known in the art to be a cross-linking agent.

As to claim 18, Edlund teaches that the starch is present in the amount of 65 – 75% of the dry substance and the vinyl acetate ethylene copolymer, or latex, is present in the amount of 20 – 30% of dry substance (column 3, lines 30 – 35).

As to claim 17, Edlund teaches the claimed invention except fails to teach the composition of the water-based glue system, or Applicant's "second dried coating".

Fagan is directed to a sheet material which can be firmly adhered to a surface, and yet readily removed therefrom, without the necessity of pre-wetting and without damaging the surface (Abstract). Fagan teaches a pressure sensitive adhesive coating comprising wax such as paraffin wax (column 4, lines 50 – 67) and a thickener, or rheology modifier (column 5, lines 36 – 45).

It would have been obvious and necessary for one of ordinary skill in the art practicing the invention of Edlund to provide the details of the water-based glue system, or Applicant's "second dried coating". Since it is desirable to easily remove wallcoverings without damaging the application surface, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the water-based glue system of Fagan in the invention of Edlund, motivated by the expectation of successfully practicing the invention of Edlund.

As to claim 19, Edlund in view of Fagan discloses the claimed invention except for that the paraffin wax is present in the amount ranging from 80 – 99% by weight and the rheology modifier is present in the amount ranging from about 1 to 20% by weight. It should be noted that the amount of wax and rheology modifier is a result effective variable. For example, as the amount of wax incases, the adhesive becomes less sticky and as the amount of rheology modifier increases, the adhesive becomes thicker. It would have been obvious to one having ordinary skill in the art at the time the invention was made to the paraffin wax is present in the amount ranging from 80 – 99% by weight and the rheology modifier is present in the amount ranging from about 1 to 20% by weight, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ

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215 (CCPA 1980). In the present invention, one would have been motivated to optimize the amount of wax and rheology modifier in the adhesive to create an easily removable and viscous solution which has a high adherence strength.

10. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edlund (US 6,291,011) in view of Fagan (US 4,783,354) and DeProspero et al. (US 5,639,539).

Edlund in view of Fagan teaches the claimed invention except fails to teach that the first coating can contain a pigment, in particular titanium dioxide.

DeProspero is directed to a releasable wall covering (Abstract). DeProspero teaches that the wall covering includes a reinforcing substrate (column 2, lines 45 – 55). DeProspero teaches that any appropriate binders, filler and pigments may be incorporated into the reinforcing substrate (column 3, lines 15 – 25). DeProspero teaches that the pigment can be titanium dioxide to impart high opacity (column 3, lines 30 – 35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a pigment of titanium dioxide in the first coating of Edlund in view of Fagan as suggested by DeProspero motivated by the desire to color the covering while imparting high covering power.

Response to Arguments

11. Applicant's arguments with respect to claims 1 - 20 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bullock et al. (US2001/0021616 A1) is directed to a treated textile fabric comprising a primary treatment of acrylic latex to a fiberglass wrapped polymeric fiber woven or non-woven fabric and a secondary treatment with a consistency similar to that of wallpaper paste comprising rheological modifiers, starch and paraffin wax. Bullock fails to teach that starch can be present in the primary treatment.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

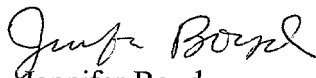
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 703-305-7082. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Jennifer Boyd
September 20, 2003

